

REMARKS

This is in response to the Office Action mailed on March 28, 2005, in which all of the pending claims (1-27) were rejected. Specifically, claims 1-16 and 20-27 were rejected under 35 U.S.C. 102(b) as being anticipated by Hill (USP 4,673,609), and claims 17-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hill in view of Yamashita (EP 0041390).

Claims 1-13

Independent claim 1, as amended, recites a dual display system having first and second opposite sides that includes a graphic article providing a first display on the first side of the dual display system in a first lighting condition, and a projection system providing a projection from the second side of the dual display system to provide a second display on the first side of the dual display system in a second lighting condition.

In rejecting claims 1-16 and 20-27, the Examiner pointed to col. 17, lines 46-52 of Hill to provide the “second display ... in a second lighting condition” recited in claim 1. However, Hill does not disclose a projection system that provides a projection from a second side (opposite the image side) of an article in order to provide a second display on a first side (the image side) of the article, as recited in amended claim 1. In contrast to amended claim 1, Hill merely discloses that “lights or images, such as those from photographic transparencies, can be projected onto the surface of the products of the invention preferably onto white or light areas on one side of the silhouette pattern, while maintaining visibility through the panel from the other side.” Col. 17, lines 46-51. This teaching would project an image onto the article from the first side (the image side) of the article, using the article as a white screen (because of the fact that the article has an opaque silhouette pattern and is not transparent from the imaging side). Moreover, this projected image would appear on the article in the same lighting condition that the article provides a visible image, not in a second lighting condition as recited in amended claim 1. In order to reject a claim under 35 U.S.C. 102, each and every element as set forth in the claim must be found, either expressly or inherently described, in the prior art. See M.P.E.P. 2131, citing Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d (BNA) 1051, 1053 (Fed. Cir. 1987). Since there is no disclosure, teaching or

suggestion in the Hill patent of the claimed projection system that provides a projection from the second side (the non-image side) of the dual display system to provide a second display on the first side of the system in a second lighting condition, the rejection of amended independent claim 1 under 35 U.S.C. 102(b) should be withdrawn.

Claims 2-13 depend from amended independent claim 1, and are allowable therewith.

In addition, it is respectfully submitted that at least some of the combinations of features recited in claims 2-13 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claims 14-21

Amended independent claim 14 recites a dual display article for attachment to a window substrate that includes a graphic article providing a first display viewable from a first direction in a high brightness condition and a diffuser attached to the graphic article for receiving and displaying a projection from a second direction opposite the first direction to provide a second display viewable from the first direction in a low brightness condition. As discussed above with respect to amended independent claim 1, the Hill patent does not disclose a diffuser that receives and displays a projection from a second direction (the non-image side) of the dual display article to provide a second display viewable from a first direction in a low brightness condition. Furthermore, Hill does not disclose a diffuser that receives and displays a projection. The Examiner has suggested that transparent colorless sheets 10 and 12 are diffusers, but there is no disclosure in the Hill patent to suggest that these sheets are diffusers for receiving and displaying a projection. Because the Hill patent does not disclose these elements recited in amended independent claim 14, the rejection of claim 14 under 35 U.S.C. 102(b) should be withdrawn.

Claims 15-21 depend from amended independent claim 14, and are allowable therewith. In addition, it is respectfully submitted that at least some of the combinations of features recited in claims 15-21 are patentable on their own merits, although this does not need to be

specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Claims 22-27

Amended independent claim 22 recites a method of displaying multiple images in different lighting conditions. The method includes attaching a perforated image film bearing a first display to a first side of a transparent substrate, the first display being visible in a first lighting condition. A diffuser screen is attached to a second side of the transparent substrate opposite the first side of the transparent substrate, and a second display is projected through the diffuser screen, the second display being viewable in a second lighting condition. As discussed above with respect to amended independent claims 1 and 14, the Hill patent does not disclose a method in which a diffuser is attached to a second side of a transparent substrate, and a second display is projected through the diffuser that is visible in a second lighting condition. The Hill patent at best discloses a system in which an image can be projected onto a perforated image film directly (not through a diffuser film), and that is visible in the same lighting condition that the first display (of the film) is visible. Therefore, because the Hill patent does not disclose each and every element recited in amended independent claim 22, the rejection of claim 22 under 35 U.S.C. 102(b) should be withdrawn.

Claims 23-27 depend from amended independent claim 22, and are allowable therewith. In addition, it is respectfully submitted that at least some of the combinations of features recited in claims 23-27 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

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-9-




CONCLUSION

In view of the foregoing, all pending claims 1-27 are in condition for allowance. A Notice to that effect is respectfully requested.

Respectfully submitted,
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